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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/802,769	03/18/2004	Tohru Harada	250617US2	4671
22850 7590 12/27/2007 OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				
			EXAMINER MORRISON, JAY A	
			ART UNIT 2168	PAPER NUMBER
			NOTIFICATION DATE 12/27/2007	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/802,769

Applicant(s)

HARADA ET AL.

Examiner

Jay A. Morrison

Art Unit

2168

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsman's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/3/07 has been entered.

Remarks

2. Claims 1-21 are pending.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 1-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Paradinas et al. ('Paradinas' hereinafter) (Publication Number 2002/0116478) in view of Shields et al. ('Shields' hereinafter) (Publication Number 2003/0225797).

As per claim 1, Paradinas teaches

A file creation method which creates a program-addition file for adding a program to a program-initiation recording medium of an information processing apparatus, comprising the steps of: (see abstract and background)

acquiring identification information of the program-initiation recording medium;
(description when card connected, paragraph [0041])

and creating a program-addition file in response to the identification information so that starting of the program on the information processing apparatus is allowed by the program-addition file with the program stored in the program-initiation recording medium. (description and application stored on the smart card to be executed when smart card connected to device, paragraphs [0039]-[0041])

Paradinas does not explicitly indicate "and model identification of the information processing apparatus" nor "and the model identification".

However, Shields discloses "and model identification of the information processing apparatus" and "and the model identification" (model number, paragraph [0047], lines 8-12).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Paradinas and Shields because using the steps of "and model identification of the information processing apparatus" and "and the model identification" would have given those skilled in the art the tools to improve the invention by allowing different actions to be performed based on the model number of devices. This gives the user the advantage of being able to take advantage of features of their particular device.

As per claim 2, Paradinas teaches
the step of transmitting the program-addition file to the information processing apparatus via a network. (paragraph [0024])

As per claim 3, Paradinas teaches
the step of storing the program-addition file in a program-addition recording medium (paragraph [0040])

which is used for the addition of the program to the program-initiation recording medium. (Minton v. Nat '1Ass'n of Securities Dealers, Inc., 336 F.3d 1373, 1381, 67 USPQ2d 1614, 1620 (Fed. Cir. 2003) "whereby clause in a method claim is not given weight when it simply expresses the intended result of a process step positively recited."

Examples of claim language, although not exhaustive, that may raise a question as to the limiting effect of the language in a claim are: (A) "adapted to" or "adapted for" clauses; (B) "wherein" clauses; and (C) "whereby" clauses. Therefore intended use limitations are not required to be taught, see MPEP § 2106 Section II(C), MPEP 2111.04 [R-3])

As per claim 4, Paradinas teaches
in the acquiring step, the identification information is acquired from a predetermined information provider device. (paragraph [0055])

As per claim 5, Paradinas teaches
the program-addition file comprises a program file, an electronic signature of the program file, a configuration file, and an electronic signature of the configuration file, so that starting of the program on the information processing apparatus is allowed by the program-addition file with the program stored in the program-initiation recording medium. (paragraphs [0039]-[0041])

As per claim 6, Paradinas teaches
the creating step comprises: acquiring the program file, the electronic signature of the program file, and the configuration file; (paragraphs [0039]-[0041])

and creating a second electronic signature of the configuration file based on the identification information of the program-initiation recording medium and the acquired configuration file. (paragraphs [0039]-[0041])

As per claim 7, Paradinas teaches
the program file, the electronic signature of the program file, and the configuration file are acquired from a predetermined information provider device.
(paragraph [0055])

As per claims 8-9,
These claims are rejected on grounds corresponding to the arguments given above for rejected claims 1-2 and are similarly rejected.

As per claim 10, Paradinas teaches
a file transmitting unit transmitting the program-addition file to a computer terminal in which the program-addition file is stored in a program-addition recording medium. (paragraphs [0039]-[0041])

As per claim 11,
This claim is rejected on grounds corresponding to the arguments given above for rejected claim 5 and is similarly rejected.

As per claim 12, Paradinas teaches

A computer terminal which stores a program-addition file in a program-addition recording medium, the program-addition file being used to add a program to a program-initiation recording medium of an information processing apparatus, the computer terminal comprising: (see abstract and background)

an information transmitting unit transmitting, to a server, information required to acquire identification information of the program-initiation recording medium;
(description when card connected, paragraph [0041])

a file receiving unit receiving, from the server, a program-addition file which is created by the server in response to the identification information so that starting of the program on the information processing apparatus is allowed by the program-addition file with the program stored in the program-initiation recording medium; (description and application stored on the smart card to be executed when smart card connected to device, paragraphs [0039]-[0041])

and a file storing unit storing the received program-addition file into the program-addition recording medium. (communication protocol, paragraph [0049])

Paradinas does not explicitly indicate “and model identification of the information processing apparatus” nor “and the model identification”.

However, Shields discloses “and model identification of the information processing apparatus” and “and the model identification” (model number, paragraph [0047], lines 8-12).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Paradinas and Shields because using the steps of “and model identification of the information processing apparatus” and “and the model identification” would have given those skilled in the art the tools to improve the invention by allowing different actions to be performed based on the model number of devices. This gives the user the advantage of being able to take advantage of features of their particular device.

As per claim 13, Paradinas teaches

This claim is rejected on grounds corresponding to the arguments given above for rejected claim 5 and is similarly rejected.

As per claim 14,

This claim is rejected on grounds corresponding to the arguments given above for rejected claim 1 and is similarly rejected.

As per claim 15,

This claim is rejected on grounds corresponding to the arguments given above for rejected claim 5 and is similarly rejected.

As per claim 16, Paradinas teaches

An information processing apparatus which adds a program to a program-initiation recording medium by using a program-addition recording medium in which a program-addition file for adding the program to the program-initiation recording medium is stored, the information processing apparatus comprising: (see abstract and background)

a recording-medium detection unit detecting the program-addition recording medium in which the program-addition file is recorded; (communication protocol, paragraph [0049])

and a program addition unit performing an authentication check of the program-addition file read from the program-addition recording medium, and adding the program to the program-initiation recording medium according to a result of the authentication check. (description and application stored on the smart card to be executed when smart card connected to device and authentication, paragraphs [0039]-[0041], [0055])

Paradinas does not explicitly indicate “based on model identification of the information processing apparatus”.

However, Shields discloses “based on model identification of the information processing apparatus” (model number, paragraph [0047], lines 8-12).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Paradinas and Shields because using the steps of “based on model identification of the information processing apparatus” would have given those skilled in the art the tools to improve the invention by allowing different

actions to be performed based on the model number of devices. This gives the user the advantage of being able to take advantage of features of their particular device.

As per claim 17, Paradinas teaches

when there are two or more program-initiation recording mediums, the program addition unit displays a screen to select one of the program-initiation recording mediums, and adds the program to the selected program-initiation recording medium.
(paragraph [0025])

As per claim 18, Paradinas teaches

This claim is rejected on grounds corresponding to the arguments given above for rejected claim 5 and is similarly rejected.

As per claim 19, Paradinas teaches

A program/addition system comprising: (see abstract and background)
a server which creates a program-addition file for being stored in a program-addition recording medium; (application developed and stored as executable code, paragraphs [0039]-[0040])

and an information processing apparatus which adds a program to a program-initiation recording medium by using the program-addition recording medium,
(application stored on smart card, paragraphs [0039]-[0040])

wherein the server is configured to acquire identification information of the program-initiation recording medium, and to create a program-addition file in response to the identification information, so that starting of the program on the information processing apparatus is allowed by the program-addition file with the program stored in the program-initiation recording medium, (description and application stored on the smart card to be executed when smart card connected to device, paragraphs [0039]-[0041])

wherein the information processing apparatus is configured to detect the program-addition recording medium in which the program-addition file is recorded, (communication protocol, paragraph [0049]) to perform an authentication check of the program-addition file read from the program-addition recording medium, and to add the program to the program-initiation recording medium according to a result of the authentication check. (description and application stored on the smart card to be executed when smart card connected to device and authentication, paragraphs [0039]-[0041], [0055])

Paradinas does not explicitly indicate “and model identification of the information processing apparatus” nor “and the model identification”.

However, Shields discloses “and model identification of the information processing apparatus” and “and the model identification” (model number, paragraph [0047], lines 8-12).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Paradinas and Shields because using the steps of “and

model identification of the information processing apparatus” and “and the model identification” would have given those skilled in the art the tools to improve the invention by allowing different actions to be performed based on the model number of devices. This gives the user the advantage of being able to take advantage of features of their particular device.

As per claim 20, Paradinas teaches

A program addition system comprising: (see abstract and background)

a server which creates a program-addition file for being stored in a program-addition recording medium; (application developed and stored as executable code, paragraphs [0039]-[0040])

and an information processing apparatus which adds a program to a program-initiation recording medium by using the program-addition recording medium, (application stored on smart card, paragraphs [0039]-[0040])

wherein the server is configured to acquire identification information of the program-initiation recording medium, and to create a program-addition file in response to the identification information, so that starting of the program on the information processing apparatus is allowed by the program-addition file with the program stored in the program-initiation recording medium, (description and application stored on the smart card to be executed when smart card connected to device, paragraphs [0039]-[0041])

wherein the information processing apparatus is configured to receive the program-addition file from the server, (communication protocol, paragraph [0049]) to perform an authentication check of the received program-addition file, and to add the program to the program-initiation recording medium according to a result of the authentication check. (description and application stored on the smart card to be executed when smart card connected to device and authentication, paragraphs [0039]-[0041], [0055])

Paradinas does not explicitly indicate “and model identification of the information processing apparatus” nor “and the model identification”.

However, Shields discloses “and model identification of the information processing apparatus” and “and the model identification” (model number, paragraph [0047], lines 8-12).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Paradinas and Shields because using the steps of “and model identification of the information processing apparatus” and “and the model identification” would have given those skilled in the art the tools to improve the invention by allowing different actions to be performed based on the model number of devices. This gives the user the advantage of being able to take advantage of features of their particular device.

As per claim 21,

This claim is rejected on grounds corresponding to the arguments given above for rejected claim 5 and is similarly rejected.

Response to Arguments

5. Applicant's arguments with respect to claims 1-21 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

6. The prior art made of record, listed on form PTO-892, and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jay A. Morrison whose telephone number is (571) 272-7112. The examiner can normally be reached on M-F 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tim Vo can be reached on (571) 272-3642. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Application/Control Number:
10/802,769
Art Unit: 2168

Page 15

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